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33356 7590 06/08/2010 SoCAL IP LAW GROUP LLP 310 N. WESTLAKE BLVD. STE 120 WESTLAKE VILLAGE, CA 91362				
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* STACY HAITSUKA, RONALD BURR, HAROLD  
MACKENZIE, MARWAN ZEBIAN, TERRY WARREN,  
SHANE BLASER, COLIN GIFFEN and MARK GOLDSTON

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Appeal 2008-004612  
Application 09/632,774  
Technology Center 1700

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Decided: June 8, 2010

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Before HUBERT C. LORIN, JOSEPH A. FISCHETTI, and  
BIBHU R. MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1-25 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

## SUMMARY OF THE DECISION

We AFFIRM-IN-PART.

## THE INVENTION

The Appellants' claimed invention is directed to a client application for enabling access to an online service and displaying advertisements while the user has access to the online service (Spec. 9:1-4). Claim 1, reproduced below, is representative of the subject matter of appeal.

1. A method of displaying advertisements to a user of an online service provider using a client application on a local device, the local device including an input device and an output device, the client application accessing an online server associated with the online service provider and providing access to the Internet, the method comprising:
  - a) the client application activating;
  - b) the client application commencing an initial online session with the online service provider to gain access to the Internet, the client application operating independently of an Internet browser and operating concurrently with the Internet browser;
  - c) the client application receiving sponsorship data from the online service provider, the sponsorship data comprising a sponsorship object including a resource locator associated with a sponsorship label to be displayed and a resource locator associated with a click-through of the sponsorship label;
  - d) the client application causing a client window to be displayed on the output device, the client window remaining fully visible so

long as the online session with the online service provider persists, wherein the client window is displayed independently of a browser window generated by the Internet browser;

e) the client application displaying a sponsorship label on the client window by referring to the resource locator associated with the sponsorship label to be displayed, the sponsorship label comprising a hypertext link, wherein, when the user clicks on the sponsorship label, the client application causes the local device to access the resource locator associated with a click-through of the sponsorship label;

f) the client application causing a first advertisement to be displayed in the client window, wherein the client application retrieves the first advertisement from a memory cache local to the local device;

g) the client application receiving a second advertisement from the online server;

h) the client application causing the second advertisement to be displayed in the client window.

### THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Filepp	US 5,347,632	Sep. 13, 1994
Angles	US 5,933,811	Aug. 3, 1999
Hassett	US 6,807,558 B1	Oct. 19, 2004

Rob Pegorao, Washington Post, *Logging On; How Much is Free Access Worth*, Oct. 8, 1999.

Charles Mandel, Canadian Business, *Is this what they call "ad nauseum"?*, Aug. 28, 1998.

The following rejections are before us for review:

1. Claims 1-25 are rejected under 35 U.S.C. § 103(a) as unpatentable over Angles, Filepp, and Pegoraro or Mandel or Hassett.

## THE ISSUES

At issue is whether the Appellants have shown that the Examiner erred in making the aforementioned rejections.

With regards to claims 1-6 this issue turns on whether Angles discloses the claim limitation “b” as recited in claim 1.

With regards to claims 7-10 this issue turns on whether Angles discloses the claim limitation “b” as recited in claim 7.

With regards to claims 11-25 this issue turns on whether the prior art discloses the specific claim limitations argued for each claim.

## FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence:<sup>1</sup>

FF1. Angles discloses system for delivering customized advertisements with an interactive communication systems (Title).

FF2. Angles at Col. 9:61-10:7 states that:

When a consumer desires to access information available on the Internet 33 via an Internet provider 34, the consumer initiates a connection with the Internet provider 34 from his or her consumer computer 12.

For example, the consumer invokes a browser which executes on the consumer computer 12. The browser, in turn, establishes a communication link directly with the Internet 33 or with the Internet provider 34 via a communications link. Once connected to the Internet provider 34, the consumer can direct the browser to access information provided by one of the content provider computers 14.

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<sup>1</sup> See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

The Internet provider 34 then communicates with the Internet 33 to establish a communications link between the consumer computer 12 and the desired content provider computer 14.

FF3. Angles at Col. 9:61-10:7 discloses that a consumer can initiate a connection to an Internet provider 34 and that the browser can establish such a communication link with the Internet provider.

FF4. Angles at Col. 9:61-10:7 does not disclose the use of a separate client application, operating independently of the Internet browser, to commence an initial online session with the online service provider.

FF5. Pegoraro discloses that a free Internet service has an advertising banner and that you can't hide or close the banner or you will be disconnected (para. 2).

## PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) In *KSR*, the Supreme Court emphasized “the need

for caution in granting a patent based on the combination of elements found in the prior art” *id.* at 415-16.

## ANALYSIS

### *Claims 1-10*

The Appellants argue that claim 1 requires the elements of claim limitation “b” in the claim and that Angles fails to disclose this limitation (Br. 10-12, Reply Br. 2-4).

In contrast the Examiner has determined that Angles disclose the cited claim limitation “b” at Col. 9:61-Col. 10:7 (Ans. 9-10).

We agree with the Appellants. Claim 1 includes limitation “b” which requires:

b) the *client application commencing* an initial online session with the *online service provider* to gain access to the Internet, the *client application operating independently of an Internet browser* and *operating concurrently with the Internet browser*.

The claim thus requires that the client application, online service provider, and Internet browser be separate and distinct from each other. Angles at Col. 9:61-10:7 does not disclose the use of a separate client application, operating independently of the Internet browser, to commence an initial online session with the online service provider (FF4) and the rejection of record has not asserted that the other cited references do.

For these reasons the rejection of claim 1 and its dependent claims is not sustained. Claim 7 contains a similar limitation as the one addressed above and the rejection of this claim and its dependent claims is not sustained for the same reasons given above.

*Claims 11-25*

The Appellants argue that the rejection of claim 11 is improper because the references fail to disclose a local device to “commence an online session with an online service provider through which the user accesses the Internet” and to “display a client window.....remaining fully visible and on top of all other windows so long as the online session persists.....browser” (Br. 17). In contrast the Examiner has determined that the combination of Angles, Filepp, and Pegoraro or Mandel or Hasset discloses these cited limitations (Ans. 15-17).

Angles had disclosed that the user can commence an online session through an Internet service provider (FF2, FF3) and Pegoraro has disclosed a free Internet service that has an advertising banner and that you can’t hide or close the banner or you will be disconnected (FF5) meeting these cited claim limitations. The advertising banner would be considered “sponsorship data” and the location of the client window on top of the other windows would be an obvious modification for focused attention on that window. For this reason the rejection of claims 11-14 is sustained.

The Appellants have provided similar arguments for claims 15-25 and the rejection of these claims is sustained for the same reasons given above as well.

**CONCLUSIONS OF LAW**

We conclude that Appellants have shown that the Examiner erred in rejecting claims 1-10 under 35 U.S.C. § 103(a) as unpatentable over Angles, Filepp, and Pegoraro or Mandel or Hasset.



We conclude that Appellants have not shown that the Examiner erred in rejecting claims 11-25 under 35 U.S.C. § 103(a) as unpatentable over Angles, Filepp, and Pegoraro or Mandel or Hasset.

#### DECISION

Examiner's rejection of claims 1-10 is reversed. The Examiner's rejection of claims 11-25 is sustained.

#### AFFIRMED-IN-PART

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